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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,491	02/21/2001	Yumiko Nakano	826.1677/JDH	6762

21171 7590 04/22/2004
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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT PAPER NUMBER

2175

DATE MAILED: 04/22/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/788,491

Applicant(s)

NAKANO ET AL

Examiner

Neveen Abel-Jalil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 9 and 11-23 is/are rejected.
- 7) ☒ Claim(s) 7 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18-February-2004 has been entered.
2. The amendment filed on February 18, 2004 has been received and entered. Claim 23 has been added. Therefore, claims 1-23 are now pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 8, 11, 13, 14-18, 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by D'Arlach et al. (U.S. Patent No. 6,026,433).

As to claims 1, and 13, D'Arlach et al. discloses an information searching apparatus for searching location information that represents the location of content

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information which is concerned with a keyword transmitted from a user's terminal apparatus (See abstract, also see column 7, lines 42-52), comprising:

a database for storing location information which is about prescribed content information that exists on the network and is unpublished on the network (See column 5, lines 14-45); and

a searching unit searching for the location information by referring to the database only when searching got the location based on a keyword that is transmitted from a user's terminal apparatus browsing specific web page containing a search keyword input field to which the keyword is input and is input in the search keyword field (See column 7, lines 11-52).

As to claims 8, and 14, D'Arlach et al. discloses an information server, connected to a network, for transmitting stored information to the network, comprising:

a search keyword input page transmitting unit transmitting a web page to a user's terminal apparatus, the web page containing a search keyword input field in which a keyword is input, the keyword causing an information searching apparatus to search for location information representing the location of content information on the network where information exists containing a keyword transmitted from the user's terminal apparatus, based on the keyword (See column 13, lines 5-7, and see column 14, lines 1-5, and see column 7, lines 4-40); and

a location unpublished information transmitting unit transmitting unpublished location information, the location of the network of which is unpublished the location information representing which the information searching apparatus can searching for

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only by inputting a keyword to search the keyword input field of the web paged browsed on the user's terminal apparatus, to the user's apparatus in response to a request issued by the user's terminal apparatus (See column 8, lines 4-43, also see column 7, lines 11-51, and see column 5, lines 34-65).

As to claims 11, and 15, D'Arlach et al. discloses a user's terminal apparatus, connected to a network, comprising:

a web page browsing unit browsing a web page containing a search keyword input field in which a keyword is input (See column 5, lines 14-32, and see column 6, lines 61-67), the keyword causing an information searching apparatus to search location information representing the location of content information the location on the network where information exists containing the keyword transmitted from the user's terminal apparatus and on which the location information of the content information, the location on the network is unpublished, can be searched for, only based on a keyword input to the search input field (See column 6, lines 21-67, wherein "location on network" reads on "web server", also see prior art, column 1, lines 24-54, and see column 8, lines 17-23); and

a search keyword transmitting unit transmitting the keyword that has been input in the search keyword input field to the information searching apparatus (See column 6, lines 43-67).

As to claims 16, 17, and 18, D'Arlach et al. discloses a computer readable storing medium for storing an information searching program, a computer data signal embodied

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in a carrier wave and representing an information searching program that causes a computer to perform a control operation for searching location information that represents the location of content information on a network where exists information containing a keyword transmitted from a user's terminal apparatus (See column 7, lines 4-52, also see column 9, lines 10-51), the information searching program comprising:

obtaining a keyword that is transmitted from the user's terminal apparatus browsing a specific web page containing a search keyword input field to which the keyword is input (See column 13, lines 5-7, and see column 14, lines 1-5, and see column 7, lines 4-40); and

making a search by referring to a database storing location information which is about prescribed content information that exists on the network and is unpublished on the network, only when searching for the location information, based on the keyword input to the search keyword input field (See column 8, lines 4-43, also see column 7, lines 11-51, and see column 5, lines 34-65).

As to claim 21, D'Arlach et al. discloses a search method, comprising:

receiving a search request including keyword and a source identifier (See column 8, lines 6-25, and see column 6, lines 36-67);

determining whether the source identifier corresponds to a search page for searching unpublished network accessible pages (See column 7, lines 26-40);

searching a published page index using the keyword when the source identifier does not correspond to the search page for searching unpublished network accessible pages (See column 9, lines 10-67, also see column 8, lines 6-25); and

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searching an unpublished page index and the published page index when the source identifier corresponds to the search page for searching unpublished network accessible pages (See column 12, lines 17-52, and see column 7, lines 26-52).

As to claim 22, D'Arlach et al. discloses a search method, comprising:

receiving a search request including keyword and a source identifier (See column 8, lines 6-25, and see column 6, lines 36-67);

determining whether the source identifier corresponds to a search page for searching unpublished network accessible pages (See column 9, lines 10-67); and

searching an unpublished page index and the published page index when the source identifier corresponds to the search page for searching unpublished network accessible pages (See column 12, lines 17-52, and see column 7, lines 26-52).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4, 6-7, 9, 12, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Arlach et al. (U.S. Patent No. 6,026,433) in view of Eggleston et al. (U.S. Patent No. 6,061,660).

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As to claim 2, D'Arlach et al. discloses wherein the content information whose location information is unpublished (See column 8, lines 1-43, also see column 12, lines 17-52).

D'Arlach et al. does not teach is award entry information.

Eggleston et al. teaches is award entry information. (See Eggleston et al. column 33, lines 56-65, also see column 35, lines 60-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified D'Arlach et al. to include is award entry information.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified D'Arlach et al. by the teaching of Eggleston et al. to include is award entry information because a database can store any user customizable information/records fitting to the user's preference regardless of its type.

As to claim 3, D'Arlach et al. as modified discloses wherein the web page contains a keyword with which the location information of the award entry information is obtained as a search result of said searching unit (See Eggleston et al. column 16, lines 32-67, and Eggleston et al. column 17, lines 1-8, wherein "location information" reads on "link to a page containing information", and wherein "award entry" reads on "incentive program").

As to claim 4, D'Arlach et al. as modified discloses wherein when a plurality of records of the location information are obtained as the search result corresponding to the

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keyword (See Eggleston et al. column 15, lines 27-56, wherein “location information” reads on “URL for the award site”), said searching unit outputs rankings corresponding to the correlation of content information represented by the location information and the keyword (See Eggleston et al. column 12, lines 49-67, wherein “searching unit” reads on “customer website...permits the customer to search”), and

wherein the award entry information is highly correlated with the keyword contained in the web page (See Eggleston et al. column 15, lines 50-56, wherein “award entry information” reads on “obtain particular prize”, and wherein “highly correlated” reads on “linked”, and wherein “web page” reads on “consumer site and the sponsor side”, also see Eggleston et al. column 12, lines 38-48).

As to claim 6, D’Arlach et al. as modified discloses wherein the web page contains an award entry keyword, wherein the award entry information is a web page containing an award keyword input field in which the entry keyword is input (See Eggleston et al. column 15, lines 50-56, wherein “award entry information” reads on “obtain particular prize”, and wherein “keyword input field” reads on “search site by topic or keyword”, also Eggleston et al. see column 12, lines 38-48), and

wherein the apparatus further comprises determining unit determining whether or not the award entry has been performed by inputting the entry keyword in the entry keyword input field (See Eggleston et al. column 14, lines 6-49, wherein “determining unit” reads on “a sponsor...is asked to select among various types... application program of the host program”, and wherein “award entry” reads on “incentive program”, and

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wherein "inputting the entry keyword" reads on "characteristics selected by the sponsor").

As to claim 7, D'Arlach et al. as modified discloses further comprising a search entry summing unit summing the number of entries (See Eggleston et al. column 31, lines 25-50, wherein "summing unit" reads on "categorized by a number of different characteristics") for each keyword that have been input in the search keyword input field and searched by said searching unit (See Eggleston et al. column 34, lines 20-53, wherein "search keyword input field" reads on "define the characteristics of a particular incentive program", also see Eggleston et al. column 27, lines 29-59).

As to claim 9, D'Arlach et al. discloses wherein the content information whose location is unpublished (See column 8, lines 6-20),

wherein an entry keyword appears on the web page, wherein the content information transmitted from said location unpublished information transmitting unit contains a web page containing an entry keyword input field in which the entry keyword is input (See column 6, lines 36-67, and see column 12, lines 12-30).

D'Arlach et al. does not teach is award entry information;

wherein the information server further comprises an accepting unit determining whether or not an award entry keyword that has been input in the entry keyword input field is the same as a search keyword that has appeared on a web page containing a search keyword input field an accepting an award entry when they are the same when the award entry is transmitted from the user's terminal apparatus through the network.

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Eggleston et al. teaches is award entry information. (See Eggleston et al. column 33, lines 56-65, also see column 35, lines 60-67);

wherein the information server further comprises an accepting unit determining whether or not an award entry keyword that has been input in the entry keyword input field is the same as a search keyword that has appeared on a web page containing a search keyword input field an accepting an award entry when they are the same when the award entry is transmitted from the user's terminal apparatus through the network (See Eggleston et al. column 5, lines 47-67, and see Eggleston et al. column 6, lines 1-20, wherein "accepting unit determining" reads on "satisfies certain pre-determine a criteria", and wherein "user's terminal apparatus" reads on "client...customer's computer", also see Eggleston et al. column 12, lines 40-67, wherein "is the same as" reads on "provides status information for the consumer regarding participation in the host incentive programs").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified D'Arlach et al. to include is award entry information;

wherein the information server further comprises an accepting unit determining whether or not an award entry keyword that has been input in the entry keyword input field is the same as a search keyword that has appeared on a web page containing a search keyword input field an accepting an award entry when they are the same when the award entry is transmitted from the user's terminal apparatus through the network.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified D'Arlach et al. by the teaching of Eggleston et al.

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to include is award entry information; wherein the information server further comprises an accepting unit determining whether or not an award entry keyword that has been input in the entry keyword input field is the same as a search keyword that has appeared on a web page containing a search keyword input field an accepting an award entry when they are the same when the award entry is transmitted from the user's terminal apparatus through the network because a database can store any user customizable information/records fitting to the user's preference regardless of its type.

As to claim 12, D'Arlach et al. discloses wherein the content information whose location is unpublished (See column 8, lines 5-25),

wherein an entry keyword appears on the web page, and wherein the user's terminal apparatus further comprises (See column 7, lines 26-52):

an entry keyword transmitting unit transmitting the keyword that has been input in the entry keyword input field to the network (See column 13, lines 5-7, and see column 14, lines 1-5, and see column 6, lines 61-67).

D'Arlach et al. does not teach is award entry information.

Eggleston et al. teaches is award entry information (See Eggleston et al. column 33, lines 56-65, also see column 35, lines 60-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified D'Arlach et al. to include is award entry information.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified D'Arlach et al. by the teaching of Eggleston et al.

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to include is award entry information because a database can store any user customizable information/records fitting to the user's preference regardless of its type.

As to claim 19, D'Arlach et al. discloses an information searching apparatus for searching for location information that represents location on a network where information containing a keyword transmitted from a user's terminal apparatus, based on the keyword (See column 9, lines 10-51), comprising:

a regular search service index database storing a keyword contained in content information that is published on the network, in connection with location information representing location on the network where the published content information exists (See column 6, lines 36-67, also see column 8, lines 1-35, and see prior art, column 1, lines 23-40);

the location on the network of which is unpublished, in connection with location information representing the location on the network where the unpublished content information exists (See column 7, lines 1-52, and see column 8, lines 1-25); and

based on a keyword transmitted from the user's terminal apparatus browsing a specific web page, and searching for the location information referring to the regular service index database when searching for location information, based on other keywords (See column 6, lines 44-67).

D'Arlach et al. does not teach a promotion index database storing a keyword contained in content information; and

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a searching unit searching for the location information referring to the regular search service index database and promotion index database when searching for location information.

Eggleston et al. teaches a promotion index database storing a keyword contained in content information (See Eggleston et al. column 20, lines 1-32);

a searching unit searching for the location information referring to the regular search service index database and promotion index database when searching for location information (See Eggleston et al. column 12, lines 12-57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified D'Arlach et al. to include a promotion index database storing a keyword contained in content information; a searching unit searching for the location information referring to the regular search service index database and promotion index database when searching for location information.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified D'Arlach et al. by the teaching of Eggleston et al. to include a promotion index database storing a keyword contained in content information; a searching unit searching for the location information referring to the regular search service index database and promotion index database when searching for location information because catering a database to specific type of record provides for efficient database based on user preference and thereby reducing business costs.

As to claim 20, D'Arlach et al. as modified wherein said specific web page is a form for award entry, and

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said searching unit making the search based on a keyword input to an award entry keyword input field provided on the specific web page (See Eggleston et al. column 33, lines 56-65, also see Eggleston et al. column 35, lines 60-67, also see Eggleston et al. column).

Allowable Subject Matter

7. Claims 5, and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record (D'Arlach et al. -U.S. Patent No. 6,026,433-and Eggleston et al. -U.S. Patent No. 6,061,660 –and - De La Huerga et al. -U.S. Patent No. 5,895,461-) do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim), wherein the award entry information contains an input field in which the keyword is input and is described in HTML (HyperText Markup Language), and wherein the award entry information is highly correlated with the keyword contained in the web page in such a manner that the keyword (is contained in a portion defined in a META tag described in HTML, as claimed in dependent claim 5.

The prior art of record (D'Arlach et al. -U.S. Patent No. 6,026,433-and Eggleston et al. -U.S. Patent No. 6,061,660 –and - De La Huerga et al. -U.S. Patent No. 5,895,461)

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do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim), wherein said keyword input page transmitting unit changes the entry keyword whenever said keyword input page transmitting unit transmits a web page containing the search keyword input field, as claimed in dependent claim 10.

Reasons for Allowance

9. Claim 23 is allowed over the prior art made of record.

10. The following is a statement of reasons for allowance:

The prior art of record (D'Arach et al. -U.S. Patent No. 6,026,433-and Eggleston et al. -U.S. Patent No. 6,061,660 –and - De La Hueraga et al. -U.S. Patent No. 5,895,461) do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim), a database which stores location information about content information including a first web page having an award entry keyword input field, the web page existing on the network and being unpublished on the network; a searching unit which searches for the location information by referring to the database only when searching for a location of the web page based on a keyword that is transmitted from a user's terminal apparatus browsing a second web page, the second web page including: a search keyword input field into which the keyword is input, and an award entry keyword; and a determining unit which determines whether the award entry keyword has been input to the award entry keyword input field, wherein the award entry keyword is changed whenever the search keyword input field is transmitted to a user, as claimed in claim 23.

Response to Arguments

11. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Davis et al. (U.S. Pub. No. 2002/0133516 A1) teaches end-to-end content publishing.

Douglass et al. (U.S. Pub. No. 2002/0040311 A1) teaches Web browser page rating system.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 703-305-8114. The examiner can normally be reached on 8:00AM-4: 30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 703-305-3830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil
April 17, 2004


CHARLES RONES
PRIMARY EXAMINER